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MAILED

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OFFICE OF PETITIONS

In re Application of	:	
Blumberg et al.	:	
Application No. 10/575,532	:	ON APPLICATION FOR
Filed: April 12, 2006	:	PATENT TERM ADJUSTMENT
Atty Docket No. 7701-0001WOUS	:	
Title: NEUTRAL DATA COMPUTER	:	
CONTROL SYSTEM FOR A MACHINE	:	
TOOL USED TO PRODUCE	:	
WORKPIECES WITH A THREADED	:	
SURFACE AND ASSOCIATED	:	
MACHINE TOOL	:	

This is in response to the "REQUEST MADE UNDER 37 CFR 1.705(b) FOR REVISION OF PATENT TERM ADJUSTMENT," filed April 29, 2010. Applicants submit that the correct patent term adjustment to be indicated on the patent is four hundred and ninety (490) days, not one hundred and fifty-five (155) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction partly on the basis that the Office will take in excess of three years to issue this patent. In addition, Applicants contend that one period of applicant delay was miscalculated.

However, prior to a decision on the letter regarding patent term adjustment being rendered, on June 18, 2010, Applicants filed a petition to withdraw from issue along with a request for continued examination (RCE). By decision mailed June 21, 2010, the withdrawal from issue was granted. Prosecution was reopened.

A Notice of Allowance and Fee(s) Due was mailed on March 12, 2010, along with a Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) which indicates that the Patent Term Adjustment to date is 155 days.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, Applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, Applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.¹

¹ For example, if Applicants dispute both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date

To the extent that Applicants otherwise request reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, the request is DISMISSED.

Applicants state that any patent issuing from the application is subject to a terminal disclaimer.²

Rule 1.704(c)(7) sets forth, in toto:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

...

Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed

A non-final Office action was mailed on March 31, 2008, and a response was received on May 30, 2008. A "Notice of Non-compliant Amendment (37 CFR 1.121)" was mailed on June 23, 2008, and on July 23, 2008, 54 (not 53) days after the initial reply of May 30, 2008 was submitted, a response was received. As such, a reduction of 54 (not 53) days was assessed.

It follows that the reduction of 54 days was properly calculated.

The \$200.00 fee under 37 C.F.R. § 1.18(e) will be charged to Deposit Account No. 13-0235 in due course. No additional fees are required.

on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then Applicants must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

² Petition, page 2.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and Applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to Applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Senior Attorney Paul Shanoski (571) 272-3225.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is positioned above the printed name.

Anthony Knight
Director
Office of Petitions